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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,630	04/07/2004	Ira Goldstein	200208339-1	8828
22879 7590 09/16/2009 HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528			EXAMINER FACTOL, NICHOLAS C	
			ART UNIT 2625	PAPER NUMBER
			NOTIFICATION DATE 09/16/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/820,630

Applicant(s)

GOLDSTEIN ET AL.

Examiner

Nicholas C. Pachol

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12-19, 21, 23, 24, 52 and 72-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-19, 21, 23, 24, 52, 72-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 1-24, filed 06/29/09, with respect to the rejection(s) of claim(s) 1-9, 12-19, 21, 23, 24, 52, and 72-74 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Rignell (US 2003/0122746) in view of Kardach (US 2003/0001020).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-5, 12, 13, 15, 18, 19, 21, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rignell (US 2003/0122746) in view of Kardach (US 2003/0001020).

Regarding Claim 1, Rignell teaches a method of associating in computer memory
(Page 2, paragraph 16)

(i) a digital electronic version of printed human-discernible content of a printed document comprising a sheet having a machine-readable pattern adapted to enable the

position of a digital pattern reading device to be determined (Page 3, paragraph 48) and said human-discernible content with

(ii) the identity of a sheet upon which the content is printed (Page 3, paragraph 50), the method comprising:

printing the content onto a sheet using a second printer, said sheet comprising a pre-patterned sheet that has been pre-printed by a first printer with said pattern (Page 2, paragraph 22 and Figure 3, element 301, wherein it is shown that the preprinted sheets are bought, therefore not printed on the same printer); and

storing a correlation between said identity code and said digital electronic version in computer memory (Page 5, paragraph 69).

Rignell does not teach transferring a machine-readable identity code between said second printer and said sheet at around the time of printing said content.

Kardach teaches transferring a machine-readable identity code between said second printer and said sheet at around the time of printing said content (Page 2, paragraph 21).

Rignell and Kardach are combinable because they both teach making edits with digital paper.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell with the teachings of Kardach for the purpose of allowing the document to be distinguished between other document though the use of an identifier (Kardach: page 1, paragraph 11).

Regarding Claim 3, Rignell does not teach wherein said identity code is printed on said sheet by said second printer.

Kardach does teach wherein said identity code is printed on said sheet by said second printer (Page 1, paragraph 11).

Rignell and Kardach are combinable because they both teach making edits with digital paper.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell with the teachings of Kardach for the purpose of allowing the document to be distinguished between other document though the use of an identifier (Kardach: page 1, paragraph 11).

Regarding Claim 4, Rignell does not teach wherein a plurality of sheets have the same pre-printed pattern as provided by the first printer and are given individual identities by using said second printer to apply different machine-readable identity codes to each of them at around the time of printing each sheet.

Kardach does teach wherein a plurality of sheets have the same pre-printed pattern as provided by the first printer and are given individual identities by using said second printer to apply different machine-readable identity codes to each of them at around the time of printing each sheet (Page 3, paragraph 27).

Rignell and Kardach are combinable because they both teach making edits with digital paper.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell with the teachings of Kardach for the purpose of allowing the document to be distinguished between other document though the use of an identifier (Kardach: page 1, paragraph 11).

Regarding Claim 5, Rignell does not teach wherein said machine-readable identity code comprises at least one code from the group:

- (i) a pattern of dots;
- (ii) a pattern of lines;
- (iii) a pattern of printed objects whose positions and/or shapes code for an identity;
- (iv) a position determining pattern;
- (v) a bar code.

Kardach does teach wherein said machine-readable identity code comprises at least one code from the group:

- (i) a pattern of dots;
- (ii) a pattern of lines;
- (iii) a pattern of printed objects whose positions and/or shapes code for an identity;
- (iv) a position determining pattern;
- (v) a bar code (Page 3, paragraph 34).

Rignell and Kardach are combinable because they both teach making edits with digital paper.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell with the teachings of Kardach for the purpose of allowing the document to be distinguished between other document though the use of an identifier (Kardach: page 1, paragraph 11).

Regarding Claim 12, Euchner teaches a method of associating in computer memory a digital electronic version of printed human discernible content of a printed document with an identity code adapted to identify said document (Page 3, paragraph 48), the method comprising:

using a plurality of pages of pre-patterned digital paper that have been pre-printed by a first printer with a position-determining pattern, said pattern being adapted to enable a digital pen to acquire information from said pattern to enable the position of said pen on said pattern to be determined (Figure 3, element 301 Page 3, paragraph 37, and Page 4, paragraph 51, wherein it is shown that the preprinted sheets are bought, therefore not printed on the same printer);

printing said content on said digital paper using a second printer (Page 2, paragraph 22);

and associating in computer memory, using said code transferred, at the time of printing said content onto said pre-patterned paper, a digital electronic version of said

content with the identity code for the particular sheet of digital paper upon which said content is printed (Page 5, paragraph 69).

Rignell does not teach using said content printer to be instrumental in conveying an identity code to or from the paper.

Kardach does teach using said content printer to be instrumental in conveying an identity code to or from the paper (Page 2, paragraph 21).

Regarding Claim 13, Rignell does not teach wherein an identity code adapted to distinguish a specific sheet of pre-pattern digital paper is printed onto said specific sheet as part of an operation of printing said content onto said specific sheet, said identity code being readable by a digital pen and being capable of being used to distinguish data acquired by a digital pen from said specific sheet from data acquired by said pen from other sheets of pre-patterned paper having the same position-determining pattern on them as does said specific sheet

Kardach teaches wherein an identity code adapted to distinguish a specific sheet of pre-pattern digital paper is printed onto said specific sheet as part of an operation of printing said content onto said specific sheet, said identity code being readable by a digital pen and being capable of being used to distinguish data acquired by a digital pen from said specific sheet from data acquired by said pen from other sheets of pre-patterned paper having the same position-determining pattern on them as does said specific sheet (Page 3, paragraph 27).

Regarding Claim 15, Rignell does not teach wherein a plurality of different identity codes are printed on a respective plurality of pre-patterned sheets each having the same pre-printed position-determining pattern, said identity codes enabling a digital pen to acquire sheet identity data to enable data acquired from each sheet to be distinguished from data acquired from other sheets

Kardach teaches wherein a plurality of different identity codes are printed on a respective plurality of pre-patterned sheets each having the same pre-printed position-determining pattern, said identity codes enabling a digital pen to acquire sheet identity data to enable data acquired from each sheet to be distinguished from data acquired from other sheets (Page 3, paragraph 27).

Regarding Claim 18, Rignell does not teach wherein said identity code is printed in an area of said pre-patterned paper which is from the group:

- (i) free of pattern;
- (ii) substantially free of pattern (Page 3, paragraph 30).

Kardach teaches wherein said identity code is printed in an area of said pre-patterned paper which is from the group:

- (i) free of pattern;
- (ii) substantially free of pattern (Page 3, paragraph 30).

Regarding Claim 19, Rignell further teaches wherein an area of said sheets from the group:

- (i) all of a surface of each of the sheets;
 - (ii) substantially all of a surface of each of the sheets;
 - (iii) at least half of the surface area of each of the sheets;
 - (iv) at least a tenth of the surface area of each of the sheets;
- are pre-printed with pattern (Page 3, paragraph 38).

Regarding Claim 21, Rignell further teaches wherein said second printer is

- (i) not capable of printing said pattern satisfactorily; or
- (ii) configured not to be capable of printing said pattern satisfactorily (Page 2, paragraph 22).

Regarding Claim 52, Rignell teaches a method of combining pen strokes made with a digital pen upon a digital sheet having pen position-determining pattern printed upon it and human-discernible content printed upon it (Page 3, paragraphs 31 and 33) comprising:

printing said sheet with said pattern in a pre-patterning operation with a first printer to create a pre-patterned sheet (Figure 3, element 301 Page 3, paragraph 37, and Page 4, paragraph 51, wherein it is shown that the preprinted sheets are bought, therefore not printed on the same printer);

subsequently printing said content onto said pre-patterned sheet using a second printer to create a content-printed digital sheet (Page 2, paragraph 22);

associating in computer memory a link between said identity code and an electronic version of said content that was printed on said sheet (Page 5, paragraph 69);

using a digital pen to make pen strokes on said content-printed sheet (Page 3, paragraph 39);

conveying pen-acquired pen-position data, relating to the position of said pen in said pattern to a processor (Page 3, paragraph 39);

the processor using the pen-acquired identity code, the pen acquired pen-position data, and the link between said identity code and said electronic version of said content to combine said pen strokes with said content (Page 3, paragraphs 39 and 49, wherein the identify code is acquired from Kardach).

Rignell does not teach transferring an identity code between said second printer and said sheet to enable the identity of said sheet to be established in a subsequent pen-on-sheet writing operation, the transfer of said identity code occurring in the same time frame as printing said content onto said sheet;

using the digital pen to acquire said identity code from said content- printed sheet.

Kardach does teach transferring an identity code between said second printer and said sheet to enable the identity of said sheet to be established in a subsequent pen-on-sheet writing operation, the transfer of said identity code occurring in the same time frame as printing said content onto said sheet (Page 2, paragraph 21);

using the digital pen to acquire said identity code from said content- printed sheet (Page 2, paragraph 26).

4. Claims 2, 6-9, 14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rignell (US 2003/0122746) in view of Kardach (US 2003/0001020) further in view of Euchner (US 7,111,230).

Regarding Claim 2, Rignell in view of Kardach does not teach wherein said identity code is read from said sheet by said second printer.

Euchner further teaches wherein said identity code is read from said sheet by said second printer (Column 9, lines 19-25).

Rignell in view of Kardach and Euchner are combinable because they all deal with editing digital documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach with the teachings of Euchner for the purpose of identifying the user who made the edits (Euchner: Column 5, lines 41-55).

Regarding Claim 6, Rignell further teaches said second printer uses data from a digital electronic version of content to print said content onto said pre-patterned sheet (Page 2, paragraph 22); and

wherein said association is made in computer memory between said digital electronic version of said content and said identity of pattern (Page 3, paragraph 48).

Rignell in view of Kardach does not teach wherein the second printer which prints said content onto said pre-patterned sheet has a pattern reading device, and wherein said second printer acquires data from said pre-printed pattern on the said sheet that is to be printed with content, in order to enable the identity of pattern on said sheet to be established, thereby enabling said association to be made in computer memory.

Euchner does teach wherein the second printer which prints said content onto said pre-patterned sheet has a pattern reading device, and wherein said second printer acquires data from said pre-printed pattern on the said sheet that is to be printed with content, in order to enable the identity of pattern on said sheet to be established, thereby enabling said association to be made in computer memory (Column 9, lines 19-38, wherein Rignell shows that the pattern is printed on a separate printer beforehand).

Rignell in view of Kardach and Euchner are combinable because they all deal with editing digital documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach with the teachings of Euchner for the purpose of identifying the user who made the edits (Euchner: Column 5, lines 41-55).

Regarding Claim 7, Rignell in view of Kardach does not teach wherein said pre-printed pattern is associated in computer memory with specific digital electronic content

and wherein upon recognition of said pattern using data acquired by said pattern reading device of said second printer, said specific digital electronic content is caused to be printed onto said pre-patterned sheet as human-discernible content.

Euchner teaches wherein said pre-printed pattern is associated in computer memory with specific digital electronic content and wherein upon recognition of said pattern using data acquired by said pattern reading device of said second printer (Column 9, lines 19-38, wherein Rignell shows that the pattern is printed on a separate printer beforehand), said specific digital electronic content is caused to be printed onto said pre-patterned sheet as human-discernible content (Column 9, lines 19-38, wherein Rignell shows that the pattern is printed on a separate printer beforehand).

Rignell in view of Kardach and Euchner are combinable because they all deal with editing digital documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach with the teachings of Euchner for the purpose of identifying the user who made the edits (Euchner: Column 5, lines 41-55).

Regarding Claim 8, Rignell in view of Kardach does not teach wherein different users have different pattern associated with them and wherein upon recognition of their pattern from data from said second printer's pattern reading device said content printer is caused to print user-specific content onto said sheet.

Euchner does teach wherein different users have different pattern associated with them and wherein upon recognition of their pattern from data from said second printer's pattern reading device said content printer is caused to print user-specific content onto said sheet (Column 5, lines 47-55).

Rignell in view of Kardach and Euchner are combinable because they all deal with editing digital documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach with the teachings of Euchner for the purpose of identifying the user who made the edits (Euchner: Column 5, lines 41-55).

Regarding Claim 9, Rignell further teaches wherein said human-discernible content comprises document-type content and user-specific content, wherein one from the group:

- (i) document-specific content; and
- (ii) user-specific content is selected by a user, and the other from said group is obtained from a predetermined correlation between said identity code that has been read by said printer and a digital electronic version said content (Page 3, paragraph 48).

Regarding Claim 14, Rignell in view of Kardach does not teach wherein an identity code adapted to distinguish a specific sheet of pre-patterned digital pattern is printed on said specific sheet in an operation prior to printing said content onto said

specific sheet, and wherein a second printer which prints said content onto said pre-patterned paper has an identity code reading device, said second printer being capable of acquiring data from said identity code, said identity code being capable of being used to distinguish data acquired by a digital pen from said specific sheet from data acquired by said pen from other sheets of pre-patterned paper having the same position-determining pattern on them as does said specific sheet, to enable said association to be made between said digital electronic version of said content and said identity code

Euchner teaches wherein an identity code adapted to distinguish a specific sheet of pre-patterned digital pattern is printed on said specific sheet in an operation prior to printing said content onto said specific sheet, and wherein a second printer which prints said content onto said pre-patterned paper has an identity code reading device, said second printer being capable of acquiring data from said identity code, said identity code being capable of being used to distinguish data acquired by a digital pen from said specific sheet from data acquired by said pen from other sheets of pre-patterned paper having the same position-determining pattern on them as does said specific sheet, to enable said association to be made between said digital electronic version of said content and said identity code (Column 8, lines 4-10 and Column 9, line 19-25).

Regarding Claim 16, Rignell in view of Kardach does not teach wherein said identity code is associated in computer memory with specific digital electronic content and wherein upon recognition of said identity code using data acquired by said identity

code reading device of said second printer, said specific digital electronic content is caused to be printed onto said pre-patterned sheet as human discernible content.

Euchner further teaches wherein said identity code is associated in computer memory with specific digital electronic content and wherein upon recognition of said identity code using data acquired by said identity code reading device of said second printer (Column 9, lines 19-25), said specific digital electronic content is caused to be printed onto said pre-patterned sheet as human discernible content (Column 9, line 19-25).

Regarding Claim 17, Rignell in view of Kardach does not teach wherein different users have different identity codes associated with them and wherein upon recognition of their identity code from data from said second printer's identity code reading device said second printer is caused to print user-specific content onto said sheet.

Euchner teaches wherein different users have different identity codes associated with them and wherein upon recognition of their identity code from data from said second printer's identity code reading device said second printer is caused to print user-specific content onto said sheet (Column 5, lines 46-55).

5. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over obviousness by Rignell (US 2003/0122746) in view of Kardach (US 2003/0001020).

Regarding Claim 23, Rignell in view of Kardach does not teach wherein said first printer has substantially better print resolution than does said second printer.

Official notice is taken that if the printed pattern can be printed by another printer, or pre-printed, then the printer that is doing the printing of the pattern would have better resolution than the second printer.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a printer to print the pattern out on a printer that has better resolution because the printer that has better resolution would be more preferable to print out the pattern.

Regarding Claim 24, Rignell further teaches wherein pre-printed digital paper is taken from said first printer and put into a plurality of second printers (Page 2, paragraph 22 Page 4, paragraph 52).

6. Claims 72-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rignell (US 2003/0122746) in view of Kardach (US 2003/0001020) further in view of Korst (US 7,050,181).

Regarding Claim 72, Rignell in view of Kardach does not teach wherein the second printer is an existing legacy printer.

Korst does teach wherein the second printer is an existing legacy printer (Column 2, lines 11-33, wherein Korst states to modify an existing legacy printer to accept

commands as if it was a regular printer. Therefore since Korst states that a legacy printer can function as a regular printer, Rignell's printer can be modified to be a legacy printer.).

Rignell in view of Kardach and Korst are combinable because they both teaching printing documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach with Korst for the purpose of having a legacy printer function as a current printer (Column 2, lines 11-15).

Regarding Claim 73, Rignell in view of Kardach does not teach wherein the second printer is an existing legacy printer.

Korst does teach wherein the second printer is an existing legacy printer (Column 2, lines 11-33, wherein Korst states to modify an existing legacy printer to accept commands as if it was a regular printer. Therefore since Korst states that a legacy printer can function as a regular printer, Rignell's printer can be modified to be a legacy printer.).

Rignell in view of Kardach and Korst are combinable because they both teaching printing documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach with

Korst for the purpose of having a legacy printer function as a current printer (Column 2, lines 11-15).

Regarding Claim 74, Rignell in view of Kardach does not teach wherein the second printer is an existing legacy printer.

Korst does teach wherein the second printer is an existing legacy printer (Column 2, lines 11-33, wherein Korst states to modify an existing legacy printer to accept commands as if it was a regular printer. Therefore since Korst states that a legacy printer can function as a regular printer, Rignell's printer can be modified to be a legacy printer.).

Rignell in view of Kardach and Korst are combinable because they both teaching printing documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach with Korst for the purpose of having a legacy printer function as a current printer (Column 2, lines 11-15).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas C. Pachol whose telephone number is 571-270-3433. The examiner can normally be reached on M-Thr, 8:00 a.m.- 4:00 p.m. (EST), Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on 571-272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

/N. C. P./
Examiner, Art Unit 2625

09/10/09